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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/763,106 | 02/16/2001 | Martin Sugar | BEIERSDORF 7 | 3482 |
| 27384 | 7590 | 10/18/2004 | EXAMINER | |
| NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD STREET 18TH FLOOR NEW YORK, NY 10022 | | | WANG, SHENGJUN | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1617 | | |

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/763,106 | SUGAR ET AL. | |
| | Examiner | Art Unit | |
| | Shengjun Wang | 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 7,12-17 and 19-24 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 7,12-17 and 19-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on July 23, 2004 has been entered.

Claim Rejections 35 U.S.C. 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7, 12-17 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Mager et al. (JP 09-301834).

4. Mager et al. exemplify a hair washing agent comprising 1-14% N-acylglutamate and 1-14% sodium lauryl ether sulfate that is applied to the hair. See abstract. It is respectfully pointed out that application of a shampoo to hair also results in application of the composition to the scalp. The claims are directed to a method of applying a composition comprising lauryl ether sulfate and more than 3% N-acylamino acids and/or salts to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are

necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1992). See MPEP 21 12.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently reduce the attachment of a lauryl ether sulfate or desorb a lauryl ether sulfate from human skin, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed. As to the new claims 19-24 which recite the step of applying to human body, note scalp is part of human body. Further, washing hair and scalp in a shower bath, shampoo would be inevitably applied to the whole body.

Claim Rejections 35 U.S.C. 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 12-17, 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (4,749,515)

7. Miyamoto et al. teaches a detergent composition having good rinsing off properties and imparting smoothness to hair and skin. The composition comprises about 0.1-20% of N-acylated compounds, wherein the preferred acylated compounds include N-lauroylglutamic acid and other

N-acyl amino acids. Lauryl ether sulfate is one of exemplified detergent agent used in the composition. See, particularly, the abstract, col. 1, lines 51-63, tables 1 and 2 in columns 5-8 and the claims.

8. Miyamoto et al. does not teach expressly using a detergent composition comprising lauryl ether sulfate, as detergent agent, and more than 3% of N-acylamino acid for bath or shampoo.
9. However, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to use a detergent composition comprising lauryl ether sulfate, as detergent agent, and more than 3% of N-acylamino acid for bath or shampoo because the addition of N-acyl amino acid would improve the rinsing properties (i.e., reducing or preventing the attachment of the detergent from the skin), and impart smoothness of the skin. As to the particular amount of N-acyl amino acid, note in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists.

In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Response to the Arguments

Applicants' remarks submitted July 23, 2004 have been fully considered. The remarks about the rejections under 35 U.S.C. 112 are found persuasive. However, the remarks regarding the rejections under 35 U.S.C. 102 are not persuasive.

Applicants argue that Mager et al. does not anticipate the claimed invention since Mager do not disclose any real examples that meet the limitation of claimed invention. The examiner notes that Mager clearly teaches a composition comprising lauryl ether sulfate and N-acyl-amino acid. The N-acyl amino acid is not an optional but one of the three embodiments disclosed by

Mager, i.e., half ester of ethoxylated sulfo-succinic acid, N-acylglutamate, and the mixture of both. The same is true as to the teaching of sodium lauryl ether sulfates.

Applicants argue that employment of a shampoo would not necessarily result in the contact of the shampoo with scalp. The arguments are not probative. Even it is true that in some particular circumstances, such as those cited by applicants, shampoo may not in contact with scalp, it can not be ignored that in most situation, shampooing do result the contact of shampoo with the scalp.

Applicants further argue the inherency issue citing In re Shetty. In re Shetty was misused in the instant situation. In re Shetty is about obvious rejections. The compounds employed therein are not disclosed in the cited references. The utility claimed is distinct and nonobvious from those in the cited reference. In the instant case, the rejection is an anticipation rejection; the compounds herein are disclosed, and is one of the few disclosed species; the utilities are essentially the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**SHENGJUN WANG
PRIMARY EXAMINER**

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Shengjun Wang
Primary Examiner
Art Unit 1617